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DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HIGHWAY
SUITE 2110
AUSTIN, TX 78759

EXAMINER

WHIPPLE, BRIAN P

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/631,058

Filing Date: July 31, 2003

Appellant(s): DAY ET AL.

Brian F. Russell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/26/07 appealing from the Office action mailed 5/25/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct (following the entry of a substitute brief filed 1/17/08).

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

QuikTxT, FAQs/How-To, 10/06/2002, Cellcom

2003/0208543 A1	Enete et al.	11-2003
2005/0044144 A1	Malik et al.	2-2005
2003/0046421 A1	Horvitz et al.	3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6, 8-9, 11-13, 15-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over QuikTxT, FAQs/How-To, 10/06/2002, Cellcom (QuikTxT), in view of Enete et al. (Enete), U.S. Publication No. 2003/0208543 A1.

As to claim 1, QuikTxT discloses a method in a data processing system for managing a messaging session (Pg. 1, What is Quik|TxT?, ln. 2-3), said method comprising the steps of:

a data processing system receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session (Pg. 2, Message Length, ln. 1-4; a message is split into multiple messages and sent as a plurality of parts);

the data processing system determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters (Pg. 2, Message Length, ln. 1-4; the preset number of characters is 160); and

transmitting the plurality of characters to a message recipient within the messaging session (Pg. 1, Who can I send Quik|TxT messages to?, ln. 1-2).

QuikTxT is silent on in response to said determining, the data processing system automatically transmitting without receipt of a send command from the message sender signifying completion of composition of the message.

However, Enete discloses in response to said determining, the data processing system automatically transmitting without receipt of a send command from the message sender signifying completion of composition of the message ([0077], especially ln. 13-17).

Enete is directed to determining that a video message has reached a size limit and then sending the portion that reaches the limit, while allowing the user to continue to record

without user intervention. This is analogous to the claimed splitting of a text message for the same reason (i.e. message length limits). There is an especially strong motivation to combine given that Enete is classified in 709/206, demand based computer conferencing, and the claimed invention is also directed to demand based computer conferencing (instant messaging). Further, Enete is utilized in IM client applications (see [0077], ln. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT by automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message as taught by Enete in order to allow a user to conform to message size limits while continuing to compose a long message uninterrupted (Enete: [0077], especially ln. 13-17).

As to claim 2, QuikTxT and Enete disclose the invention substantially as in parent claim 1, including transmitting an indication that the transmitted plurality of characters forms only a portion of the message (QuikTxT: Pg. 2, **Message Length**, ln. 1-4; indication is given by labeling the plurality of parts as “part 1 of 3, part 2 of 3, ect. [sic]”).

As to claim 4, QuikTxT and Enete disclose the invention substantially as in parent claim 1, including concatenating another plurality of characters that forms a portion of the

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message to the transmitted plurality of characters, thereby creating concatenated characters (QuikTxT: Pg. 2, Message Length, ln. 1-4; messages over a predefined length are split into a plurality of parts and can be received as “part 1 of 3, part 2 of 3, ect. [sic]”, which equates to concatenating another plurality of characters to the transmitted plurality of characters); and transmitting the concatenated characters to the message recipient within the messaging session (QuikTxT: Pg. 2, Message Length, ln. 1-4).

As to claim 5, QuikTxT and Enete disclose the invention substantially as in parent claim 4, including determining that the number of characters of the another plurality of characters is at least equal to a preset number of characters (QuikTxT: Pg. 2, Message Length, ln. 1-4; any message over 160 characters will split into multiple messages, therefore a message over 320 characters will split into more than two parts, as the second part would be over 160 characters, which equates to determining that the number of characters of the another plurality of characters is at least equal to a preset number of characters); and

wherein the step of concatenating is performed once it is determined that the number of characters of the another plurality of characters is at least equal to the preset number of characters (QuikTxT: Pg. 2, Message Length, ln. 1-4; messages over a predefined length are split into more than two parts and can be received as “part 1 of 3, part 2 of 3, ect. [sic]”,

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which equates to concatenating another plurality of characters possessing a number of characters at least equal to a preset number of characters).

As to claim 6, QuikTxT and Enete disclose the invention substantially as in parent claim 1, including determining that the end of the message is not contained within the plurality of characters (QuikTxT: Pg. 2, Message Length, ln. 1-4; messages over a predefined length are split into a plurality of parts, based on the end of the message not being contained in a plurality of characters being equal to or less than 160 characters).

As to claims 8 and 15, the claims are rejected for the same reasons as claim 1 above.

As to claims 9 and 16, the claims are rejected for the same reasons as claim 2 above.

As to claims 11 and 18, the claims are rejected for the same reasons as claim 4 above.

As to claims 12 and 19, the claims are rejected for the same reasons as claim 5 above.

As to claims 13 and 20, the claims are rejected for the same reasons as claim 6 above.

Claims 3, 10, and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over QuikTxT and Enete as applied to claims 2, 9, and 16 above, and further in view of Malik et al. (Malik), U.S. Publication No. 2005/0044144 A1.

As to claim 3, QuikTxT and Enete disclose the invention substantially as in parent claim 1, but are silent on the indication is a predefined character appended to the plurality of characters.

However, Malik discloses the indication is a predefined character appended to the plurality of characters ([0053], ln. 1-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT and Enete by utilizing a predefined character appended to a plurality of characters as an indication as taught by Malik in order to easily and briefly identify additional information relevant in a messaging environment.

As to claims 10 and 17, the claims are rejected for the same reasons as claim 3 above.

Claims 7, 14, and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over QuikTxT and Enete as applied to claims 1, 8, and 15 above, and further in view of Horvitz et al. (Horvitz), U.S. Publication No. 2003/0046421 A1.

As to claim 7, QuikTxT and Enete disclose the invention substantially as in parent claim 1, but are silent on the message sender defines the preset number of characters.

However, Horvitz discloses the message sender ([0089], ln. 1-8) defines the preset number of characters ([0086], ln. 16-23; “number of characters sent”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT and Enete by allowing the message sender to define the preset number of characters as taught by Horvitz in order to facilitate personalization according to user desires (Horvitz, Abstract, ln. 10-12).

As to claims 14 and 21, the claims are rejected for the same reasons as claim 7 above.

(10) Response to Argument

- **Argument 1** (see page 7)

However, *QuikTxT* teaches using a send command to send the message when it is complete. Furthermore, *QuikTxT* relies upon the send command to determine whether to split a message into multiple messages and whether to truncate a message longer than 640 characters. Without receipt of a send command, *QuikTxT* is unable to split a large message into multiple messages or truncate a message that exceeds 640 characters. Modifying

QuikTxT to send a message without receipt of a send command would thereby change the principle operation of *QuikTxT*. (*QuikTxT*, p.2, paragraph 2 and paragraph 6).

In response to argument 1, Examiner is in agreement with Appellant regarding *QuikTxT*'s reliance upon a send command. However, Examiner respectfully disagrees with the argument that modifying *QuikTxT* to send a message without receipt of a send command changes the principle operation of *QuikTxT* is not persuasive. The principle operation of *QuikTxT* is communicating a text message from one user to another (page 1, paragraph 1, "*QuikTxT* is a complete mobile message solution and an easy way of communicating."). The transmission of portions of said messages with or without reliance upon a send command is not the primary concern of *QuikTxT*.

Examiner does not rely upon *QuikTxT* to disclose automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message. Rather, Enete discloses this subject matter. Appellant's statement that *QuikTxT* relies upon a send command to determine whether to split a message into multiple messages appears to suggest that the Appellant is attacking the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that “*QuikTxT* relies upon the send command to determine whether to split a message into multiple messages”, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *QuikTxT* by automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message as taught by Enete in order to allow a

user to conform to message size limits while continuing to compose a long message uninterrupted (Enete: [0077], especially ln. 13-17).

- **Argument 2** (see page 7)

On the other hand, *Enete* teaches automatically send a video message when the limit is read and to begin recording another video message without user intervention (paragraph 0077, lines 13-17). Modifying *Enete* to rely upon a send command to determine whether to split a message into multiple messages would thereby change the principle operation of *Enete*. It would therefore not be obvious to one skilled in the art to modify *QuikTxT* with *Enete* to achieve the claimed invention.

In response to argument 2, Examiner is not suggesting that Enete should be modified to rely upon a send command. Rather the very fact that Enete does not rely upon a send command to transmit a portion of a message is what is the teaching being referenced to modify the teachings of *QuikTxT*.

In response to applicant's argument that Enete does not rely upon a send command, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the

combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT by automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message as taught by Enete in order to allow a user to conform to message size limits while continuing to compose a long message uninterrupted (Enete: [0077], especially ln. 13-17).

In response to both arguments 1 and 2, QuikTxT teaches the general state of the art of messaging, specifically that messages beyond a certain length may be separated into a plurality of messages. QuikTxT specifically teaches splitting any message over 160 characters into a plurality of messages and sending the messages as “part 1 of 3, part 2 of 3, ect. [sic]”

(QuikTxT, page 2, paragraph 6). QuikTxT does not teach automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message. Enete is directed to determining that a video message has reached a size limit and then sending the portion that reaches the limit, while allowing the user to continue to record without user intervention. This is analogous to the claimed splitting of a text message for the same reason (i.e. message length limits). There is an especially strong motivation to combine given that Enete is classified in 709/206, demand based computer conferencing, and the claimed invention is also directed to demand based computer conferencing (instant messaging). Further, Enete is utilized in IM client applications (see [0077], ln. 11). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the technique of automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message as taught by Enete, to improve messaging system of QuikTxT for the predictable result of allowing a user to conform to message size limits while continuing to compose a long message uninterrupted.

- **Argument 3** (see pages 8-9)

The Examiner states in paragraph 21 of the Final Office Action that the combination of *QuikTxT* and *Enete* is “silent on the indication is a predefined character appended to the

plurality of characters.” The Examiner interprets *Malik* at paragraph [0053], lines 1-20 as disclosing the indication as predefined character appended to a plurality of characters. However, the cited portion of *Malik* teaches adding an additional character to a domain name, not a portion of a message, as claimed.

Furthermore, the additional characters disclosed by *Malik* are used to “identify [the user] as being registered under the Universal IM server 425” (para. [0053], lines 3-4). The additional characters are not used as “an indication that a transmitted plurality of characters forms only a portion of a message”, as claimed.

Claim 3 does not merely claim that there is an indication. Claim 3 depends from Claim 2, and “the indication” of Claim 3 has antecedent basis to the indication of Claim 2, specifically “an indication that the transmitted plurality of characters forms only part of the message.” *Malik* does not teach such an indication as claimed.

In response to argument 3, the applicant’s argument that *Malik* is directed to a domain name and not a portion of a message is not persuasive, as both are a “plurality of characters” as claimed in claim 3.

Furthermore, the argument that *Malik* is directed to a different indication than the claimed invention is also not convincing as claim 3 merely states that there is an indication.

The purpose of the indication is irrelevant and motivation would exist for combining Malik with QuikTxT given the language of the claim.

Additionally, appending a character to form an indication is extremely well known in the art. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT by combining Malik's teaching of appending a character to form an indication.

Appellant appears to be attacking the references individually. While Malik may be directed to an indication separate from the one taught by the combination of QuikTxT and Enete, it is the combination of teachings as a whole and what they would suggest that must be considered and not merely each art's individual teachings alone. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

QuikTxT and Enete disclose the invention substantially, including transmitting an indication that the transmitted plurality of characters forms only a portion of the message (QuikTxT: Pg. 2, **Message Length**, ln. 1-4; indication is given by labeling the plurality of parts as "part 1 of 3, part 2 of 3, ect. [sic]").

Malik discloses the indication is a predefined character appended to the plurality of characters ([0053], ln. 1-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of QuikTxT and Enete by utilizing a predefined character appended to a plurality of characters as an indication as taught by Malik in order to easily and briefly identify additional information relevant in a messaging environment.

QuikTxT teaches an indication is given by labeling the plurality of parts as “part 1 of 3, part 2 of 3, ect. [sic]” (page 2, paragraph 6). Malik teaches giving an indication by affixing a character. Because both are known methods for displaying an indication, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of displaying an indication for another to achieve the predictable result of displaying an indication. A symbol, such as an @ sign, at the end of the message would achieve the same purpose of indicating that the transmitted plurality of characters forms only a portion of a message. A user knowing the meaning of the terms would be able to identify a portion of a message through either a character affixed to the plurality of characters or a message such as “part 1 of 3.”

- **Argument 4** (see page 9)

Claims 3, 7, 10, 14, 17, and 21 are allowable due to the argued allowability of claims 1, 8, and 15.

In response to argument 4, Examiner disagrees with the arguments put forth by Appellant regarding the allowability of claims 1, 8, and 15. Therefore, claims 3, 7, 10, 14, 17, and 21 are maintained as rejected properly.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian P. Whipple
/Brian P Whipple/
Examiner, Art Unit 2152
3/18/08

Conferees:

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152

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/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146